REMARKS

The Examiner is thanked for withdrawing the prior anticipation rejection.

Status of Claims

Claims 42-61 are currently pending. Claims 42 and 56 are amended in this paper. No new matter has been added.

Section 101 Issues

Claims 42-55 are rejected under 35 U.S.C. §101 as being non-statutory.

To address this rejection, independent claim 42 has been amended such that the "receiving," "applying" and "creating" steps are now carried out in the "performance management transaction server," which server is a "particular machine" within the meaning of *In re Bilski*, 88 USPQ 2d 1385 (Fed. Cir. 2008). Nothing more is required to satisfy Section 101.

The Examiner is requested to withdraw the 35 U.S.C. §101 rejection in view of these amendments and arguments.

Section 112 Issue

Claims 56-61 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention because "it is unclear which structure is performing the applying and creating functions." Helpfully, the Examiner has suggested a proposed amendment to claim 56 to address this issue. The Examiner is thanked for this helpful suggestion, and the claim has been amended accordingly.

The identified claims should now be in compliance with §112(2).

Section 103 Issue

Claims 42-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Powers et al, U.S. Patent No. 6,615,182, in view of Wolfston Jr., U.S. Patent No. 5,815,155.

Respectfully, this rejection is traversed.

A determination regarding alleged obviousness under 35 USC §103(a) requires an analysis of the "scope and content" of the cited art.

Powers describes a system and method for defining the organizational structure of an enterprise in a performance evaluation system. The approach described in the patent addressed the problem of then-prior systems that only used "predefined organizational structures" that often did not match the actual structures used in the business. In addition, the systems (prior to Powers) required that any custom privileges, evaluations, and reports be hard-coded for each evaluation tool, which lead to high implementation and administration cost. Powers addressed these deficiencies by providing a performance evaluation system in which the organizational structure of an enterprise could be accurately defined to custom fit quality and productivity tools to the structure of the enterprise. To that end, Powers provided a computer system that enabled the organizational structure of the enterprise to be defined by storing a plurality of user-defined levels. A user-defined hierarchy is then stored for the levels. The system also enables the user to store a plurality of user-defined members. Each member is associated with a level to define the organizational structure of the enterprise. The performance evaluation system generates user views based on the user-defined levels, hierarchy and members and the assignment of members to levels.

Figures 5B of Powers illustrates several of the tables that may be created in the Powers system. One of them is the "expression assignment table 160" that assigns expressions to the performance areas. When associated with a performance area, the expressions are used to compute a productivity score for that performance area. In the expression assignment table 160, a first field identifies a performance area by a performance area ID and a second field identifies an expression assigned to the performance area by an expression ID. One or more expressions may be assigned to each of the performance areas. In addition, an expression may be re-used between performance areas. For example, performance areas 1 and 6 may each include expression 1.

Wolfston describes a system of user navigation through large computer programs with many screens that provides the user with a set of clickable actuators that indicate the path taken to the user's current position in the hierarchy and that provide an intuitive method for returning to any previous level. The patent is cited solely for its teaching of a screen display containing user-selectable options that take a user to various hierarchical levels (citing column 5, lines 1-7) ("Selecting any of these options navigates the user to a different screen display at the next lower hierarchical level.").

Turning to the "differences" between the cited art and the claims, the Examiner admits, correctly, that Powers does not "expressly teach wherein each data dictionary field comprises a user-selectable level of the hierarchy to which the data dictionary field is to be applied." (Office Action, at page 6). Wolfston is said to disclose this feature, however. With respect, it does not.

Wolfston only teaches enabling a user to select a given level of the hierarchy, but the current claim language of above-captioned Application actually is more specific; as described in currently pending claim 42, for example, the "user interface" provides for each "data dictionary field" to include its own "user-selectable level of the hierarchy to which the data dictionary field is to be applied." In one illustrative embodiment, and as shown in the example below (from Figure 4A), the field definition screen includes a listbox from which the user selects the particular hierarchy level for that field. In other words, the broadest reasonable interpretation of the claim phrase (under MPEP §2111) is that each "data dictionary field" in the data dictionary have a "user-selectable" hierarchy level; this phrase is not merely saying a "user" selects a hierarchy level per se, which is how the Examiner

appears to be reading the phrase.

"wherein each data dictionary field comprises
a user-selectable level of the hierarchy to
which the data dictionary field is to be applied"

Fig. 4(a)

"[E]very limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines." *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970); *See also In re Wilson*, 424 F. 2d 1382, 1385 (CCPA 1970) ("[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.").

Of course, one cannot show non-obviousness by attacking references individually where the rejection is based on a combination of the references; *In re Keller*, 642 F.2d 413, 416 (CCPA 1981). Applicants are not attacking the rejection on this basis. Rather, a test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art, *Id.* at 426. Here, the "combined teachings" of Powers and Wolfston describe a performance evaluation system that enables an organization's structure to be defined and managed with respect to a plurality of user-defined levels (Powers), and wherein performance reports can be generated at some user-selected level of the organization (Wolfston). The claims, however, are more specific, as they require the following subject matter (emphasis supplied) that is not present in either Powers or Wolfston:

Claim 42:

> providing a <u>user interface by which a user defines a data dictionary</u>, the data
> dictionary defining processing of performance management data, wherein the
> data dictionary comprises one or more data fields, an operator for defining an
> operation to be applied to performance management data in at least one of the
> data fields, and <u>wherein each data dictionary field comprises a user-selectable
> level of the hierarchy to which the data dictionary field is to be applied;</u>

Claim 56:

> a <u>user interface allowing a user to define a data dictionary</u>, the data dictionary
> defining processing of performance management data, wherein the data
> dictionary comprises one or more data fields, an operator for defining an
> operation to be applied to performance management data in at least one of the
> data fields, and <u>wherein each data dictionary field comprises a user-selectable
> level of the hierarchy to which the data dictionary field is to be applied.</u>

Thus, each independent claim "as a whole" still is not found in the combined
teachings of Powers and Wolfston, which is a requirement to establish prima facie
obviousness of a claim under 35 USC §103(a). With respect, the Examiner has not meet this
burden.

In particular, rejections based on §103 must rest on a factual basis with these facts
being interpreted without hindsight reconstruction of the invention from the prior art. The
Examiner may not "resort to speculation, unfounded assumptions or hindsight reconstruction
to supply deficiencies in its factual basis." *In re Warner*, 379 F.2d 10100, 1017 (CCPA
1967), *cert. denied*, 389 U.S. 1057 (1968). Here, the limitation directed to "each data
dictionary field comprises a user-selectable level of the hierarchy to which the data dictionary
field is to be applied" is nowhere found in either of the cited references.

Claims 42 and 56 are not a simple substitution of the Wolfston "user-selectable"
browsing scheme into the Powers performance evaluation system. *See, KSR Int'l v. Teleflex,
Inc.*, 127 S Ct. 1727, 1740-41 (2007). Rather, by enabling the operator to define each data
dictionary field at a particular user-selectable level of an organizational hierarchy,
embodiments of the claimed performance management method or apparatus may provide a
user "with a consolidated view of [his] or [her] own performance or that of their teams,
departments, sites or business units" (see, e.g., Application as filed, page 2, lines 27-29).

Accordingly, a Notice of Allowance is again requested.

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SERIAL NO.:   09/672,829
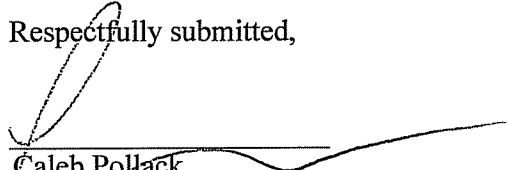FILED: September 27, 2000
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Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

No fees are believed to be due in connection with this paper. However, if any such fees are due, please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

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